

REMARKS

Claims 40-42, 50-56, and 61-64 are currently pending. The Examiner presents several rejections that are rebutted in the following order:

- I. Claims 40-42 and 50-56 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over US Patent No. 6,067,467 To John.
- II. Claims 40-42 and 50-56 are rejected under 35 U.S.C. § 112 ¶ 1 as allegedly failing to comply with the written description requirement.
- III. Claims 40-42 and 50-56 are rejected under 35 U.S.C. § 112 ¶ 2 as allegedly being indefinite.
- IV. New Claims 61-64 are allegedly non-elected subject matter according to 37 CFR 1.142(b) and MPEP § 821.03.

I. The Claims Are Not Obvious In View Of John

Obviousness is currently determined based upon an evaluation of the magnitude of the differences between the claimed embodiment and the asserted prior art:

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966), the Court set out a framework for applying the statutory language of § 103 "Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained

KSR v. Teleflex, 127 S. Ct. 1727, 1734 (2007). Further, the *KSR* holding only cautioned against a strict application of the "teaching-suggestion-motivation test" such that an explicit teaching is not required to be found within the cited applications. Nonetheless, *KSR* has NOT changed the law regarding the requirement to establish a prima facie case

of obviousness by: i) finding some motivation to combine the references either explicitly or implicitly, ii) finding a teaching or suggestion of all the claim limitations in the cited references; and iii) demonstrating that the references provide sufficient technical detail such that one having ordinary skill in the art would be provided with a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991); and *MPEP § 2142*; Establishing A Prima Facie Case Of Obviousness. The Applicants rely upon the argument made in the previous response (herein incorporated by reference) and further submit the argument below demonstrating that the Examiner has not made a prima facie case of obviousness.

A. John Does Not Teach The Applicant's Method

The Examiner states that:

Since the prior art renders obvious the steps of the invention, a rejection was made.

Office Action pg 4. The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 40 & 54 to recite that the second electroencephalogram is recorded when the patient is "awake". *See, Applicant's Specification pg 41 ln 16.* This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicant's business interests, better define one embodiment and expedite the prosecution of this application.

John does not teach the step of obtaining a second electroencephalogram from an awake patient for comparison to a first electroencephalogram. Any interpretation of John that the second electroencephalogram might be from an awake patient would result in an 'inoperable invention'. It is well settled patent law that a reference 'teaches away' in regards to obviousness if the teachings result in the inoperability of the asserted reference:

Indeed, if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose. . . . French teaches away from the board's proposed modification. . . . Because the PTO has failed to establish a prima facie

case of obviousness, the rejection of claims . . . as unpatentable under 35 U.S.C. §103 must be reversed.

In re Gordon, 733 F.2d 900, 902, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984)[emphasis added]. Specifically, John teaches a method to monitor and adjust the level of anesthesia by comparing sequential post-induction EEG recording periods wherein the probability of being awake is compared to the probability of being unconscious:

These two probabilities are compared. If the probability that the patient is awake exceeds, with a determined guardband (extent) the probability that the patient is unconscious, then an alarm is generated by the system.

John, col 10 ln 41- 44. Consequently, John's method becomes inoperable when two electroencephalogram recordings are compared wherein both recordings are taken from an awake patient because the comparative algorithm is designed to prevent an anesthetized patient from becoming awake.

As such the Applicants submit that a prima facie case of obviousness has not been made and respectfully request that the Examiner withdraw the present rejection.

II. The Claims Comply With The Written Description Requirement.

The Examiner states that:

The instant invention does not sufficiently describe the invention as it related to the excluded paroxysmal events.

Office Action, pg 5. The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended the claims to delete reference to "paroxysmal events". This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

Consequently, the claims comply with the Written Description requirement and the Examiner is respectfully requested to withdraw the present rejection.

III. The Claims Are Not Indefinite

The Examiner states that:

The claims as written are ambiguous because it is unclear what specific symptoms and diseases resulting from paroxysmal events are excluded from the instant invention.

Office Action pg 6. The Applicants disagree and submit the present rejection is moot based upon the above claim amendment. Further, the Applicants have made voluntary amendments to improve claim clarity by deleting the recitation that a patient is “medication and drug free”. This amendment is made not to acquiesce to the Examiner’s argument but only to further the Applicants’ business interests, better define one embodiment and expedite the prosecution of this application.

IV. New Claims 61-64 Are Not Non-Elected Subject Matter

The Examiner states that:

Newly submitted claims 61-64 are directed to an invention that is independent or distinct from the invention originally claimed ... wherein step ‘d’ is directed to an outcome selected from Clinical Global Improvement score, a Hamilton-D score, or a Beck Depression score.


Office Action pg 7. The Applicants disagree, traverse the present restriction and respectfully request reconsideration. The Applicants’ new Claims 61-64 merely represent an amendment of Claim 1. The fundamental scope of the embodiment has not been substantively changed such that the Examiner now faces an undue examination burden.

The Applicants respectfully request that the Examiner withdraw the present rejection.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 781.828.9870.

Dated: August 25, 2009

By: 
Thomas C. Howerton
Registration No. 48,650

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
781.828.9870